

REMARKS

Applicants have received and carefully reviewed the Office Action of the Examiner mailed August 8, 2007. Currently, claims 11-21 remain pending and have been rejected. In this response, claims 11, 16, and 20 have been amended, without conceding the correctness of the Examiner's rejection. Also, the Specification has been amended in this amendment. Favorable consideration of the following remarks is respectfully requested.

Priority Objection

On page 2 of the Office Action, the claim for priority has been objected to by the Examiner. The Examiner has indicated that Applicant cannot claim priority to the European Patent Application filed October 27, 1993 (EP 93117403.1) because the present application was filed more than twelve months thereafter. Although the formal Filing Receipt reflects such a claim, review of the Preliminary Amendment filed on October 29, 2003 shows that the priority claim was amended and does not include European Application No. EP 93117403.1. A Request for Corrected Filing Receipt is filed concurrent with this response.

Claim Rejections under 35 U.S.C. § 103

On page 2 of the Office Action, claims 11-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boussignac et al. (U.S. Patent No. 5,378,237) in view of Mueller (U.S. Patent No. 4,948,643). After careful review, Applicant respectfully traverses the rejection.

Turning to claim 11, which recites:

11. A catheter comprising: a first catheter tube having at least two superposed layers of materials, including an inner layer and an outer layer, secured together with a mediator layer, and with mechanical properties differing from one another, a lumen in the first catheter tube, and a balloon sealingly surrounding the first catheter tube, whereby the inner layer comprises high-density polyethylene and forms the lumen, and the outer layer comprises a polymer and forms an outer surface of the first catheter tube, wherein the first catheter tube includes a distal end and the outer layer extends to the distal end of the first catheter tube.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (See MPEP § 2143.03). As amended, claim 11 recites, "wherein the first catheter tube

includes a distal end and the outer layer extends to the distal end of the first catheter tube”. Nowhere does the combination of Boussignac et al. and Mueller teach or suggest this limitation.

Instead, at least as suggested by the Examiner, Boussignac et al. appears to teach an inner layer (1) and an outer layer (5) secured together by a mediation layer (29). However, as clearly illustrated in Figures 10 and 11 of Boussignac et al., cited by the Examiner, the outer layer (5) does not extend to the distal end of the catheter tube. Furthermore, nowhere does Mueller remedy the deficiencies of Boussignac et al. Therefore, Applicant believes that the combination of Boussignac et al. and Mueller fails to teach or suggest all the claim limitations of claim 11, as is required. Thus, for at least these reasons, claim 11 is believed to be patentable over Boussignac et al. in view of Mueller, and Applicant respectfully requests withdrawal of the rejection.

Additionally, for similar reasons, as well as for other reasons, claims 12-15, which depend from claim 11 and include significant additional limitations, are believed to be patentable over Boussignac et al. in view of Mueller, and Applicant respectfully requests withdrawal of the rejection.

Turning to claim 16, which recites:

16. A catheter comprising: a catheter tube having at least two superposed layers of materials, including an inner layer and an outer layer, secured together and with mechanical properties differing from one another, a guidewire lumen in the catheter tube for the sliding fit of a guidewire, and a balloon with a distal end sealingly surrounding the outer layer of the catheter tube, wherein the inner layer comprises high-density polyethylene and forms the guidewire lumen, and the outer layer comprises a polyamide and forms an outer surface of the catheter tube, and wherein the catheter tube further comprises a mediator layer providing adhesive anchorage between the inner layer and the outer layer.

As amended, claim 16 recites, “a balloon with a distal end sealingly surrounding the outer layer of the catheter tube”. Nowhere does the combination of Boussignac et al. and Mueller teach or suggest this limitation.

Instead, Boussignac et al. teach the distal end of the balloon (2) attached to the inner layer (1). Furthermore, the distal end of the outer layer (5) of Boussignac et al. terminates adjacent to the proximal end of the balloon (2) and, as such, cannot have the distal end of balloon (2) sealingly surrounding the outer layer (5). Therefore, for at least this reason, claim 16 is believed to be patentable over Boussignac et al. in view of Mueller, and Applicant respectfully requests

withdrawal of the rejection.

Additionally, for similar reasons, as well as for other reasons, claim 17, which depends from claim 15 and includes significant additional limitations, is believed to be patentable over Boussignac et al. in view of Mueller, and Applicant respectfully requests withdrawal of the rejection.

Turning to claim 18, which recites:

18. A catheter comprising:
- (a) a tube comprising:
 - (i) an outermost layer comprising a polymer having a first coefficient of friction;
 - (ii) an innermost layer coextensive with the outermost layer and forming a lumen, the innermost layer comprising a high-density polyethylene having a second coefficient of friction which is less than the first coefficient of friction; and
 - (iii) a middle layer disposed between the outermost layer and the innermost layer and affixing the outermost layer to the innermost layer; and
 - (b) a balloon sealed to the tube.

As can be seen, claim 18 recites, “an innermost layer coextensive with the outermost layer”. To be coextensive, the innermost layer and the outermost layer have the same limits, boundaries, or scope. As such, the distal end of the innermost layer is at the same position as the distal end of the outermost layer. As discussed above, nowhere does the combination of Boussignac et al. and Mueller teach or suggest this limitation. Therefore, for at least this reason, claim 18 is believed to be patentable over Boussignac et al. in view of Mueller, and Applicant respectfully requests withdrawal of the rejection.

Additionally, for similar reasons, as well as for other reasons, claim 19, which depends from claim 18 and includes significant additional limitations, is believed to be patentable over Boussignac et al. in view of Mueller, and Applicant respectfully requests withdrawal of the rejection.

Turning to claim 20, which recites:

20. A catheter comprising:
- (a) a first tube comprising:
 - (i) an outermost layer comprising a polymer having a first coefficient of friction;
 - (ii) an innermost layer coextensive with the outermost layer and

forming a lumen, the innermost layer comprising a high-density polyethylene having a second coefficient of friction which is less than the first coefficient of friction; and

(iii) a middle layer disposed between the outermost layer and the innermost layer and affixing the outermost layer to the innermost layer;

(b) a second tube disposed about a portion of the first tube; and

(c) a balloon with a distal end sealingly surrounding the outermost layer of the first tube and a proximal end sealingly surrounding the second tube.

As can be seen, claim 20 recites, “an innermost layer coextensive with the outermost layer” and “a balloon with a distal end sealingly surrounding the outermost layer of the first tube”. As discussed above, nowhere does the combination of Boussignac et al. and Mueller teach or suggest these limitations. Therefore, for at least this reason, claim 20 is believed to be patentable over Boussignac et al. in view of Mueller, and Applicant respectfully requests withdrawal of the rejection.

Additionally, for similar reasons, as well as for other reasons, claim 21, which depends from claim 20 and includes significant additional limitations, is believed to be patentable over Boussignac et al. in view of Mueller, and Applicant respectfully requests withdrawal of the rejection.

Double Patenting Rejections

On page 4 of the Office Action, claims 11 and 13-21 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,659,977. It was stated that though the claims are not identical, they are not patentably distinct from each other.

On page 4 of the Office Action, claims 11-13 and 16-21 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, and 7 of U.S. Patent No. 6,319,228. It was stated that though the claims are not identical, they are not patentably distinct from each other.

While Applicant does not concede the correctness of the rejections, to further prosecution in this case, an appropriate Terminal Disclaimer is filed herewith. Accordingly, Applicant respectfully requests withdrawal of the rejections.

Conclusion

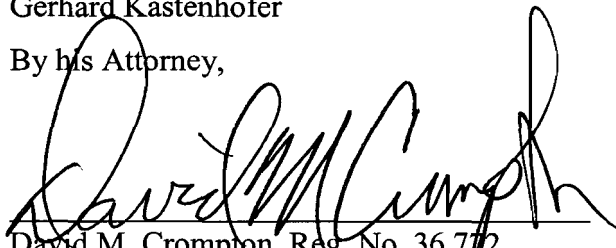
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his Attorney,

Date: 11/8/07


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